

## REMARKS/ARGUMENTS

The office action of June 15, 2006, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 2-5, 7-8, 12-14, and 16-20 have been amended to present the claims in a more preferred format. Claims 27-47 have been added. Claims 1-23 and 27-47 remain pending.

Applicants have amended a portion of the Specification to maintain consistency between the original Figures and the original Specification. No new matter has been added. Applicants have added new claims 27-47. New claims 27-47 merely place multiple dependent claims 3-5, 7-8, 12-14, and 16-20 into separate dependent claims that depend from one other claim. No new matter has been added that would require a further search.

Claims 1-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Birdwell et al. (U.S. Pat. No. 6,108,706, hereinafter referred to as *Birdwell*) in view of Robinson (U.S. Pat. No. 6,618,585, hereinafter referred to as *Robinson*). Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Even if the references were combined, the combination still would not teach or suggest all the claim features. As admitted by the Action, *Birdwell* does not “explicitly disclose requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier; and receiving the further information via one of the first or second network.” (Action, p. 2). To support this deficiency of *Birdwell*, the Action relies on column 3, line 42 to column 4, line 20 of *Robinson*.

The cited portion of *Robinson* describes an Internet enabled broadcast receiving apparatus that includes two modes of operation. (Col. 3, ll. 42-47). In a first mode of operation, the apparatus operates as a conventional public broadcast receiving device. (Col. 4, ll. 1-8). Under *Robinson*, in this first mode of operation, the apparatus may only receive data from the

public broadcast. In a second mode of operation, a user can select an Internet broadcast channel for reception from one or more menus on the device. (Col. 4, ll. 9-12). Once a specific channel has been selected, a controller causes a signal to be sent to request receipt of the selected channel and the received signal is then presented to a user. (Col. 4, ll. 12-20). The two modes of operation of *Robinson* are independent of each other.

Applicants' claim 1 recites, among other features, "requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier." Applicants respectfully disagree that *Robinson* teaches or suggest this feature of claim 1. As described above, *Robinson* describes two separate modes of operation. The Action appears to correlate the request for a specific Internet broadcast channel in *Robinson* to Applicants' requesting further information from the computer network. However, this alleged further information is not "based on the received identifier" that was received via the second network as in Applicants' claim 1. In *Robinson*, a user receives the listing of Internet broadcast channel options on her apparatus only when in the second mode of operation. Those options are received from the Internet broadcast network source, not a separate source from which the Internet broadcast channel is then selected. For at least the above-stated reasons, Applicants submit that the combination of *Birdwell* and *Robinson* fails to teach or suggest each and every feature of Applicants' claim 1. As such, Applicants' claim 1 is allowable over the art of record and Applicants respectfully request the withdrawal of the rejection.

Still further, even assuming, without admitting, that the combination of *Birdwell* and *Robinson* does teach or suggest each and every feature of Applicants' claim 1, there is not proper motivation for combining the two references. The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Applicants contend that there is no motivation or suggestion to combine *Birdwell* with *Robinson*.

The Action provides its motivation to combine stating, "[a]t the time the invention was made it would have been obvious to one in the ordinary skill in the art to incorporate requesting information based on received identifier via first or second network as disclosed by *Robinson* in

the method of accessing information on a computer network on a communication device as disclosed in Birdwell to make the device more versatile and flexible resulting in reliable multi-connectivity to a communications networks." (Action, page 3, emphasis added). Again, this is not a motivation to combine references, but is a conclusion that has apparently been reached after having benefited from reading Applicants' own disclosure, and is thus impermissible hindsight. The Action fails to cite any portion of *Birdwell* or *Robinson* for the motivation to combine. Applicants find no motivation to combine the references for at least these reasons.

Applicants respectfully submit that there is no motivation or suggestion to combine *Birdwell* with *Robinson*. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Action provide any evidence that the combination includes knowledge other than that gleaned from Applicants' disclosure. Thus, the combination is improper based on hindsight.

Applicants' claims 2-8, which depend on claim 1, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Like claim 1, Applicants' independent claim 9 also recites "the further information is based on the received identifier." Thus, for at least similar reasons as explained above with respect to Applicants' claim 1, Applicants' claim 9 is patentably distinct over the combination of references.

Applicants' claims 10-23, which depend on claim 9, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

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